Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

CANADIAN TIRE CORPORATION, LIMITED
v.
COOPER TIRE & RUBBER COMPANY
96-23(R)
Opposition No. 86,446
July 12, 1996
***1** Filed: March 27, 1996

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Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Request for Reconsideration

Cooper Tire & Rubber Company has requested reconsideration of the Commissioner's decision dated March 8, 1996, denying its petition to reverse a non-final interlocutory order of the Trademark Trial and Appeal Board (the "Board") in the above-referenced opposition proceeding. Although the Trademark Rules do not specifically provide for requests for reconsideration of decisions on petitions, the Commissioner has the discretion to consider such requests pursuant to Trademark Rule 2.146(a)(3), 37 C.F.R. § 2.146(a)(3). Upon reconsideration, the petition is granted to the extent that the Commissioner's decision dated March 8, 1996 is modified in part. The request upon reconsideration to include the newspaper article in the record is denied.

FACTS

Canadian Tire Corporation, Limited ("Opposer") filed a Notice of Opposition against registration of Petitioner's Application Serial No. 74/079,106 for the mark MOTOMASTER, based in part upon prior and continuous use of the same mark in Canada and the U.S. After numerous extensions of the trial dates, the period for rebuttal testimony closed on May 9, 1994.

On February 15, 1995, Petitioner filed a Motion to Reopen its Discovery and Testimony Periods (the "Motion"), in view of newly discovered evidence, consisting of an article which appeared in a Toronto newspaper. Petitioner requested further discovery by means of interrogatories, document requests and admissions. Opposer filed a response in opposition to the Motion.

On July 26, 1995, the Board denied Petitioner's Motion. On August 25, 1995, Petitioner filed a Request for Reconsideration that was later denied by the Board on October 4, 1995. On October 31, 1995, Petitioner filed a petition to the Commissioner for reversal of the non-final interlocutory order of the Board. The petition was denied on March 8, 1996. This Request for Reconsideration followed.

DECISION

Paragraph four of the March 8, 1996 decision denying Petitioner's petition to the Commissioner read, in part, as follows:

> On July 26, 1995, the Board denied Petitioner's Motion and noted the following: 1) Petitioner's Motion was filed late in the proceeding, after Opposer had filed its main brief and shortly before Petitioner's brief was due; 2) Petitioner failed to show not only that the evidence is newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence; 3) Petitioner sought not merely to introduce the newspaper article, but to reopen discovery to "ascertain if additional facts should be brought to the Board's attention" and subsequently to amend its pleadings; 4) Petitioner did not have in hand evidence that would enable it to amend its pleadings to include the defenses of abandonment based on continuous nonuse or lack or standing; and 5) it was much too late in the proceeding to permit a reopening of discovery in order to allow Petitioner the opportunity to investigate potential defenses for which it presently has no concrete evidence ...

***2** As noted by the Petitioner in its Request for Reconsideration, the petition decision contained a misstatement concerning the Board's action denying Petitioner's Motion. That is, the Board stated in its action that "it is obvious that [Petitioner] did not have access earlier to the newspaper article with respect to opposer's intended closing of its U.S. Auto Source stores" not that "Petitioner failed to show not only that the evidence is newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence." Therefore, upon reconsideration, the petition is

corrected to the extent that point two in paragraph four, asserting that Petitioner failed to show not only that the evidence was newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence, is deleted from the Commissioner's decision.

Nevertheless, the Commissioner finds no clear error or abuse of discretion for the other reasons stated in the Commissioner's decision. A motion to reopen is a matter committed to the sound discretion of the Board. See Federal Rule of Civil Procedure 6(b). When a party moves to reopen based upon newly discovered evidence, the mere fact that the party is able to show that the evidence could not have been discovered earlier through the exercise of reasonable diligence does not, in and of itself, mean that the motion must be granted. The nature and purpose of the evidence sought to be added, the stage of the proceeding, the adverse party's right to a speedy and inexpensive determination of the proceeding and the need for closure once the trial period has been completed (barring some compelling reason to reopen), are all factors which must be considered by the Board in determining a motion to reopen such as this. The Board clearly and properly weighed those factors in reaching its decision on the motion.

Also in its Request for Reconsideration, Petitioner requests clarification concerning whether the Commissioner will grant Petitioner's request, made in its petition to the Commissioner, to include the newspaper article in the record. Upon reconsideration, this request is denied. Had the Board believed that introduction of the article into the record was warranted, the Board could have elected to accept it as part of the record in spite of denying the Petitioner's Motion to Reopen its Discovery and Testimony Periods. Nevertheless, the Board did not do so. Considering the hearsay nature of the article, and the fact that it pertains to an unpleaded defense for which Petitioner has no present evidentiary basis, the Commissioner sees no clear error or abuse of discretion with respect to this non-final decision by the Board.

The opposition file will be forwarded to the Board for resumption of the opposition proceeding.

40 U.S.P.Q.2d 1537

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